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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/828,747	04/21/2004	Taylor J. Leaming	02-AU-089 (52039)	5486
7590	06/19/2006		EXAMINER	
Mario Donato, Jr. STMicroelectronics, Inc. 1310 Electronics Dr. Carrollton, TX 75006			CAPUTO, LISA M	
			ART UNIT	PAPER NUMBER
			2876	

DATE MAILED: 06/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/828,747

Applicant(s)

LEAMING, TAYLOR J.

Examiner

Lisa M. Caputo

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 3-8, 10-11, 13-18, 20-21, 23-28, 30-31, and 33-38 is/are rejected.
- 7) ☒ Claim(s) 2,9,12,19,22,29 and 32 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 July 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>0704</u> . | 6) <input type="checkbox"/> Other: ____.  |

## **DETAILED ACTION**

### ***Specification***

1. The abstract of the disclosure is objected to because the term "may" appears and makes the abstract seem indefinite (i.e. "An integrated circuit for a smart card may include a transceiver and a processor for communicating..." is indefinite because it is known whether the integrated circuit includes the transceiver or not). Correction is required. See MPEP § 608.01(b).

### ***Claim Objections***

2. Claim 1 is objected to because of the following informalities:

Regarding claim 1, lines 1-2: The preamble states "An integrated circuit for a smart card and comprising:". Please remove the "and" so that the sentence is grammatically correct.

Appropriate correction is required.

### ***Double Patenting***

3. Claims 1, 3-8, 10-11, 13-18, 20-21, 23-28, 30-31, and 33-38 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-7, 9-16, 18-25, and 27-35 of copending Application No. 10/829,007 to Leaming, from hereinafter "'007 application" in view of Tello (U.S. Patent No. 6,463,537).

Although the conflicting claims are not identical, they are not patentably distinct from each other because in claims 1, 3-8, 10-11, 13-18, 20-21, 23-28, 30-31, and 33-38 of the instant application, applicants claim an integrated circuit for a smart card

comprising a transceiver and a processor for communicating with a host device via a transceiver and performing a plurality of smart card applications wherein the processor cooperates with the host device to perform an enumeration based upon at least one default descriptor, generate a look-up table for allocating data to respective smart card applications based on the enumeration and detecting a system event, cooperating with the host device to perform a new enumeration based upon the alternate descriptor and generating a new look-up table based thereon. The '007 application discloses an integrated circuit for a smart card comprising a transceiver and a processor for communicating with a host device via said transceiver, the processor providing at least one default descriptor to the host device, cooperating with the host device to perform an enumeration based upon the at least one default descriptor, and detecting a system event, and responsive to the system event, providing at least one alternate descriptor to the host device and cooperating with the host device to perform a new enumeration based thereon. The '007 patent however, fails to teach the use of a look-up table to store information.

Tello teaches a computer security system which utilizes an encrypted table of smart card code numbers are also stored in the flash memory of the security engine. This table is used during the operation of the invention to identify the purpose and type of smart card inserted in the smart card reader which is logically connected to the security engine (see col 9, lines 26-31). Hence, Tello teaches the use of a look-up table which stores smart card information during smart card processes. It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ

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the teachings of Tello to the '007 patent because both systems are teaching the interfacing of computers with other objects.

Thus, with respect to the above discussions, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the teachings of claims 1-7, 9-16, 18-25, and 27-35 of the '007 patent, along with Tello as a general teaching for using the integrated circuit for the smart card as set forth in the instant application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

#### ***Allowable Subject Matter***

4. Claims 1, 3-8, 10-11, 13-18, 20-21, 23-28, 30-31, and 33-38 would be allowable if a timely terminal disclaimer is filed.

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5. Claims 2, 9, 12, 19, 22, 29, and 32 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten to overcome the Provisional Double Patenting rejection set forth in this Office Action and if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

6. The following is a statement of reasons for the indication of allowable subject matter: The best prior art of record fails to specifically teach the steps of performing an enumeration for data placement in a look-up table, and then a subsequent enumeration to be placed in an updated look-up table after a system event is detected.

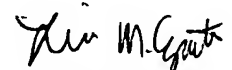
### **Conclusion**

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Lisa M. Caputo** whose telephone number is **(571) 272-2388**. The examiner can normally be reached between the hours of 8:30AM to 5:00PM Monday through Friday. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached at **(571) 272-2398**. The fax phone number for this Group is (571) 273-8300.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [**[lisa.caputo@uspto.gov](mailto:lisa.caputo@uspto.gov)**].

*All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.*

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Lisa M. Caputo  
June 11, 2006